

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 7-9, 11-14, 15, 17, 19, 20, 22, 23, and 25 have been cancelled without prejudice or disclaimer and claims 1, 4, 24, 29, 32, 33, 39, 42, 45, and 61 have been amended, and claims 63-79 have been added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 34, 47-50, and 62 are withdrawn.

Claims 1-6, 24, 26-46, 52-61, and 63-79 are pending and under consideration.

ELECTION/RESTRICTION:

In the Office Action, at page 2, item 2, the Examiner withdrew claims 20, 22, and 23, reasoning that "these claims read on the non-elected embodiment of Species IV."

Claims 20, 22, and 23 have been cancelled without prejudice or disclaimer.

DOUBLE PATENTING:

In the Office Action, at page 10, item 15, the Examiner provisionally rejected claims 7, 8, 11, 14, 15, 17, 29, 31, 39-46, 52-57, and 61 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of co-pending Application No. 10/385,566.

In the Office Action, at page 11, item 16, the Examiner provisionally rejected claims 32 and 33 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of co-pending Application No. 10/644,937.

In the Office Action, at page 3, item 5, the Examiner rejected claims 1-6, 24-28, 30 and 58-60 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of co-pending Application No. 10/385,566 in view of Banicevic et al. (U.S. 6,034,294 - hereinafter Banicevic).

Since Applications 10/385,566 and 10/644,937 are currently pending, Applicants respectfully hold any actions with respect to the double patenting rejections in abeyance until the remaining issues have been resolved.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action, at page 3, item 5, the Examiner rejected claims 1-6, 24, 25, 27, 28, 58, and 60 under 35 U.S.C. §102(b) as being anticipated by Franck (US 3,835,660 – hereinafter Franck). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 4, item 6, the Examiner rejected claims 32, 33, 37, and 38 under 35 U.S.C. §102(b) as being anticipated by Silva (US 5,284,023 – hereinafter Silva). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

The MPEP states: “[t]o anticipate a claim, the reference must teach every element of the claim.” (MPEP 2131).

The MPEP then quotes: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Quoted in MPEP 2131).

The MPEP further quotes “[t]he elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.” *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). (Quoted in MPEP 2131).

Claim 25 has been cancelled without prejudice or disclaimer.

Amended, independent claim 1 recites: “...a support panel disposed within the partition wall and contacting and supporting the outer casing.”

Amended, independent claim 24 recites: “...a support panel positioned within the partition wall to contact and support the support member and an inner surface of a rear wall of the outer casing.”

Amended, independent claim 32 recites: “...a support panel disposed within the partition wall and contacting and supporting the outer casing....”

Independent claim 38 recites: “...wherein the intermediate chassis is interposed, at a first end thereof, between the cover housing and the outer casing, and is bent at a second end thereof toward a lower edge of the cover housing to cover the lower edge of the cover housing.”

And independent claim 58 recites: “...a support panel to support the support member, provided in the predetermined space defined between the inner and outer casings, adjacent to

the partition wall structure at a first end of the support panel, and adjacent to the outer casing at a second end of the support panel."

In Franck, neither strip 20 nor elongated clamping means 20a contact or support outer shell 15.

Applicants respectfully submit that neither Franck nor Silva, either alone or in combination, disclose or suggest "...a support panel disposed within the partition wall and contacting and supporting the outer casing."

Regarding claim 38, as shown in FIG. 4 of Silva, Applicants respectfully submit that, contrary to the Examiner's assertion, a second end of electrical wire channel 24 is not bent toward a lower edge of roof member 50 (made up of top layer of sheet metal 52, insulation 56, and bottom layer of sheet metal 54) to cover the lower edge of roof member 50. (See Silva, at FIGS. 2 and 4, and col. 5, lines 1-13).

And regarding claim 58, Applicants respectfully submit that, contrary to the Examiner's assertion, no part of strip 20 or elongated clamping means 20a is adjacent to outer shell 15.

Applicants respectfully submit that Franck and Silva, either alone or in combination, fail to disclose every element of the claims, arranged as required by the claims.

Accordingly, Applicants respectfully submit that independent claims 1, 24, 32, 38, and 58 patentably distinguish over the cited art, and should be allowable for at least the above-mentioned reasons. Further, Applicants respectfully submit that claims 2-6, 27, 28, 33, and 37, which variously depend from independent claims 1, 24, or 32, should be allowable for at least the same reasons as claims 1, 24, and 32, as well as for the additional features recited therein.

#### REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at page 5, item 8, the Examiner rejected claims 26 and 59 under 35 U.S.C. §103(a) as being unpatentable over Franck. The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 5, item 9, the Examiner rejected claims 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over Franck in view of Strufe (US 1,685,248 – hereinafter Strufe). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 6, item 10, the Examiner rejected claims 30 and 31 under 35 U.S.C. §103(a) as being unpatentable over Franck in view of Wetherholt (US 5,908,229 – hereinafter Wetherholt). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 6, item 11, the Examiner rejected claims 39-41, 52-57, and 61 under 35 U.S.C. §103(a) as being unpatentable over Franck in view of Solak et al. (US 4,970,874 – hereinafter Solak). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 7, item 12, the Examiner rejected claims 33, 35, and 36 under 35 U.S.C. §103(a) as being unpatentable over Silva in view of Solak. The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 8, item 13, the Examiner rejected claims 11, 14, 15, 17, 29, and 42-46 under 35 U.S.C. §103(a) as being unpatentable over Wetherholt in view of Franck. The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Claims 7, 8, 11, 14, 15, and 17 have been cancelled without prejudice or disclaimer.

As a general matter, to establish a *prima facie* obviousness rejection, the Examiner needs to provide evidence of the existence of individual elements corresponding to the recited limitations, a motivation to combine the individual elements to create the recited invention, and a reasonable expectation of success. (See MPEP, at 2143. – “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.’ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”, and at 2143.03 – “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.’ *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).”).

Should the Examiner fail to provide evidence that the individual elements exist in the prior art, or that the motivation exists in the prior art or in the knowledge generally available to one of ordinary skill in the art, then the Examiner has not provided sufficient evidence to maintain a *prima facie* obviousness rejection of the claim. (See MPEP, at 2143.03, and

2143.01). Thus, the burden is initially on the Examiner to provide evidence as to why one of ordinary skill in the art would have been motivated to combine the individual elements to create the recited invention, and to demonstrate that this evidence existed in the prior art or in the knowledge generally available to one of ordinary skill in the art. (MPEP 2143.01).

Amended, independent claim 29 recites: "...a support member installed in the partition wall at a position adjacent to the partition wall structure to support the partition wall structure...."

Independent claim 30 recites: "...a support panel to support the support member."

Amended, independent claim 39 recites: "...a support panel disposed within the partition wall and contacting and supporting the outer casing...."

Amended, independent claim 42 recites: "...a support panel disposed within the partition wall and contacting and supporting the outer casing...."

Amended, independent claim 45 recites: "...a support panel disposed within the partition wall and contacting and supporting the outer casing...."

And amended, independent claim 61 recites: "...a support panel disposed within the partition wall and contacting and supporting the outer casing...."

Regarding claims 26 and 59, the Examiner asserts that it would have been obvious to incorporate at least one if not more openings into a panel structure for the purpose of providing a lighter structure that retains the overall strength and stability of the panel." Yet the Examiner provides no cited basis for such an assertion. To the extent that the Examiner believes the cited references disclose such a feature based upon personal knowledge, personal knowledge, when used as a basis for a rejection, must be supported by an affidavit as to the specifics of the facts of that knowledge when called for by the applicant. (See, MPEP 2144.03, 37 C.F.R. § 1.104(d)(2)). In short, the rules of the U.S. Patent and Trademark Office require that the Examiner must either support this assertion with an Affidavit, or withdraw the rejection. Therefore, Applicants respectfully request that the Examiner support the rejection with either an affidavit or a reference, or withdraw the rejections of claims 26 and 59.

Regarding independent claim 30, the Examiner asserts that the motivation for one of ordinary skill in the art to modify the cabinet of Franck to incorporate the sealing member taught by Wetherholt is "because this arrangement would provide Franck with the means to inhibit the flow of insulation material from areas or spaces not requiring the material. Applicants respectfully disagree.

Since the purpose of strip 20 with clamping means 20a, which the Examiner asserts corresponds to the claimed support member, is to clamp a portion of tubing 22 in high heat exchange with strip 20 to prevent condensation on the mullion. Applicants respectfully submit that there is no motivation for one of ordinary skill in the art to dispose what the Examiner calls "sealing blocks" of Wetherholt between clamping means 22 and walls 16 or 17, as required by independent claim 30, since to do so, as suggested by the Examiner, would inhibit flow of insulation material and therefore reduce the effectiveness of the high heat exchange relation between the tubing 22 and the strip 20. (See Fanck, at FIG. 3, col. 3, lines 60-64, and col. 4, lines 36-46).

Applicants respectfully submit that none of the cited references, either alone or in combination disclose or suggest "...a support panel disposed within the partition wall and contacting and supporting the outer casing."

Applicants respectfully submit that independent claims 29, 30, 39, 42, 45, and 61 patentably distinguish over the cited art, and should be allowable for at least the above-mentioned reasons. Further, Applicants respectfully submit that claims 26, 31, 33, 35, 36, 41-44, 46, 52-57, and 59, which variously depend from independent claims 24, 29, 39, 42, or 58, should be allowable for at least the same reasons as claims 24, 29, 39, 42, and 58, as well as for the additional features recited therein.

#### NEW CLAIMS:

Applicants respectfully submit that for at least similar reasons as those stated in the sections regarding the rejections under 35 U.S.C. §§102 and 103, new claims 63-79, which ultimately depend from independent claim 1, patentably distinguish over the cited art and should be allowable.

#### CONCLUSION:

In accordance with the foregoing, Applicants respectfully submit that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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